

Appln No. 10/820,480
Amdt date October 31, 2007
Reply to Office action of October 12, 2007

REMARKS/ARGUMENTS

In the Final Rejection dated October 12, 2007, the Examiner maintained the rejection of claims 1-30 under 35 U.S.C. §103(a) as allegedly obvious over Moaddeb, et al. (U.S. Patent No. 6,405,078) in view of Skalsky, et al. (U.S. Patent No. 4,844,099). In maintaining this rejection, the Examiner argues both that the phrase "configured to avoid substantial contact with tissue" is "subjective and arbitrary," and that the limitation is disclosed in Skalsky. Applicant respectfully traverses these arguments.

First, the phrase "configured to avoid substantial contact with tissue" is not arbitrary. Although the Examiner asserts that the term "substantial" "varies as dictated by the definition applied to it," one of ordinary skill in the art to which the specification pertains would readily recognize the meaning of this limitation. Terms such as "substantial" and "substantially" are widely used in patent applications, and numerous patents have issued having claims using this term. Moreover, the MPEP expressly acknowledges the legitimate use of the term "substantially." MPEP §2173.05(b)(D) (citing *In re Nehrenberg*, 126 U.S.P.Q. 383 (CCPA 1960)(holding that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was legitimate and not indefinite) and *In re Mattison*, 184 U.S.P.Q. 484 (CCPA 1975)(holding that the limitation "which produces substantially equal E and H plane illumination patterns" was legitimate and not indefinite). Accordingly, the phrase "configured to avoid substantial contact with tissue" is not arbitrary and is not indefinite.

Second, Skalsky fails to disclose that the non-conductive porous material is configured to avoid substantial contact with the tissue. As discussed in Applicant's responses to the previous Office actions, Skalsky discloses a pacing lead with both porous and conductive characteristics on its surface. The pacing lead in Skalsky relies on the porous components of the surface to facilitate attachment of the lead to the tissue. Column 2, lines 21-23. Indeed, the Skalsky pacing lead requires substantial contact of the non-conductive porous components with tissue to enable attachment of the pacing lead to the tissue. Without such substantial contact, Skalsky's pacing lead would have a dramatically decreased ability to attach to tissue.

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In particular, throughout the disclosure of Skalsky, the need for secure and reliable attachment of the electrode to the heart wall is highlighted. See, e.g. column 2, lines 5-33. To accomplish this, the porous characteristics of the Skalsky electrode are used to facilitate attachment to the cardiac tissue by promoting tissue ingrowth. See column 2, line 54 to column 3, line 8. Accordingly, the porous substrate (60) in Skalsky is specifically adapted to substantially contact tissue, as without such substantial contact of the porous substrate with tissue, the desired attachment to tissue could not occur. Moreover, Skalsky highlights the need for *maximum* contact of the porous substrate with tissue. Although the Skalsky electrode includes electrode leaves (66) made of a conductive material, the surface area of these leaves is *minimized*, with the remaining surface area being attributable to the porous substrate (60). See Column 6, lines 29-41 (noting that although the surface area of the leaves is minimized, a "relatively large total surface area is in direct contact with the heart tissue"). Given this disclosure in Skalsky, it is *not* fair to assert that the non-conductive porous material is configured to avoid substantial contact with the tissue, as the Examiner suggests. Applicant also notes in this regard that the Examiner has provided no basis for the contention that it is fair to make such an assertion and points to no disclosure in Skalsky supporting that statement. Accordingly, if the Examiner continues to make this assertion, Applicant requests that the Examiner specify a basis for the assertion and point to support in Skalsky for the assertion.

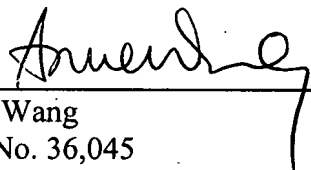
In maintaining the rejection over Moaddeb and Skalsky, the Examiner also argues that "if one arbitrarily describes Skalsky with respect to its circumferential axis...then a fair assertion is that Skalsky discloses a conductive material (112) covering/encapsulating/being outside of non-conductive material (116) in [F]igure 15." Office action, page 11. While applicant disagrees with the Examiner's argument and analysis, applicant has amended independent claims 1, 15, 29 and 30 in an effort to expedite allowance of this application. In particular, Applicant has amended independent claim 1 to recite a conductive porous coating adapted to cover a circumferential surface of the non-conductive porous material. In addition, Applicant has amended independent claim 15 to recite a thin metal coating adapted to cover a circumferential surface of the non-conductive porous material. Applicant has also amended independent claim

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29 to recite a conductive porous coating generally encapsulating a circumferential surface of the non-conductive porous material. Finally, Applicant has amended claim 30 to recite an outer conductive porous material on a circumferential surface of the inner non-conductive porous material. Skalsky fails to teach or suggest the catheters described in independent claims 1, 15, 29 and 30. Accordingly, independent claims 1, 15, 29 and 30, and all claims dependent therefrom, including claims 2-14 and 16-28, are allowable over Moaddeb and Skalsky.

Claims 1-30 remain pending in this application. By this amendment, Applicant has amended claims 1, 15, 29 and 30. The amendments find full support in the original specification, claims and drawings, and no new matter is presented. In light of the above amendments and remarks, Applicant submits that all of pending claims 1-30 are in condition for allowance. Applicant therefore respectfully requests a timely indication of allowance. However, if there are any remaining issues that can be addressed by telephone, Applicant invites the Examiner to contact Applicant's counsel at the number indicated below.

Respectfully submitted,
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